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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/271,024	03/17/1999	ASGEIR SAEBO	CONLINCO-036	3480

23535 7590 03/26/2003

MEDLEN & CARROLL, LLP
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EXAMINER

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/271,024

Applicant(s)

SAEBO ET AL.

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-8 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-8 and 13-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Receipt of applicants' amendments and remarks, and Mr. Saebo's declaration submitted December 9, 2002 is acknowledged.

Claim Rejections 35 U.S.C. 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

1. Claims 5-8 are rejected under 35 U.S.C. 102(a) as being anticipated by Cain et al. (WO 97/18320, IDS) for reasons set forth in the prior office action.

Claim Rejections 35 U.S.C. – 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cain et al. (WO 97/18320, IDS) for reasons set forth in the prior office action.

Claims 5-8 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nilsen et al. (US 5,885,594) in view of Cain et al. (WO 97/18320, IDS), further in view of Pariza et al. (U.S. Patent 5,017,614) for reasons set forth in the prior office action.

Response to the Arguments

Applicants' amendments and remarks, and Mr. Saebo's declaration submitted December 9, 2002 have been fully considered, but are not persuasive for reasons discussed below.

4. The declaration under 37 CFR 1.132 filed December 9, 2002 is insufficient to overcome the rejection of claims 5-8 and 13-17 based upon Cain et al. and Nilsen et al. and Cain et al. as set forth in the last Office action because: while the declaration provide sufficient evidences showing the criticality of less than 1% of 8,10; 11,13; and trans, trans isomers, it fails to present convincing evidence showing that the fatty composition disclosed by Cain actually comprises more than 1% isomers identified herein. See the discussion below.

With respect to the teaching of Cain et al., Applicants improperly interpreted Cain's teaching. Cain states state "The fatty acid composition of the product, as determined by FAME GC, contained 63.8% CLA, of which 48.9% was the cis 9, trans 11 isomer and 51.1 % was the trans 10, cis 12 isomer." See page 16, lines 17-21. Note CLA is conjugated linoleic acids, including those identified as impurities herein. (bother 8,10; 11,13; or trans, trans isomers are conjugated linoleic acids). Cain et al do not expressly teach what the remain 36.2 percent of the fatty composition are. However, nowhere in Cain states that "conjugated linoleic acid" are exclusively for c9, t11; and t10,c12 isomers. Any new definition of "CLA" would be improper.

In response to applicants' arguments that Mr. Saebo's experiments show that fatty composition obtained by Cain would comprise significant amount of 8,10; 11, 13 and other isomers, note Applicant generated data, proffered to obviate prior art teachings, lacks the probative force accorded data generated by independent, disinterested parties. It is well settled patent law "that it is not a difficult matter to carry out a process in such a fashion that it will not

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be successful and, therefore, the failures of experimenters who have no interest in succeeding should not be accorded great weight" In re Michalek, 74 USPQ 108, at 109 citing Bullard Company et al v. Coe, 147 F.2d. 568, 64 USPQ 359.

In response to applicants' arguments that Pariza only show small scale purification, and is not suitable for preparation of acyglycerols, the examiner notes that there is no limitation as to the quantity of the composition in claims 5-8. Further, even Pariza does not teach expressly large scale purification, a method of large scale separation/purification would be obvious in view of Pariza's teaching. Particularly, preparative HPLC would be obvious to one of ordinary skill in the art with similar condition.

The claimed invention is still properly rejected.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Examiner



Shengjun Wang

March 21, 2003



RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200